

REMARKS

Claim Rejections

Claims 18-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Himmel et al (U.S. 6,993,319 B2). Claims 1-2, 5-7, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son (U.S. 2005/0197169 A1) in view of Bashan et al (U.S. 6719206 B1). Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seita (U.S. 6973327 B2) in view of Bashan et al (U.S. 6719206 B1). Claims 3, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son and Bashan as applied to claims 1, 5 and 10 above, and further in view of Arisawa et al (U.S. 2003/0141989 A1). Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seita and Bashan as applied to claim 14 above, and further in view of Arisawa et al (U.S. 2003/0141989 A1). Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel as applied to claim 18 above, and further in view of Arisawa et al (U.S. 2003/0141989 A1).

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

Claim Amendments

By this Amendment, Applicants have amended claims 1, 5, 10, and 14 to better protect what Applicant regards as the invention. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Applicant teaches: an apparatus for radio frequency identification including, *inter alia*, a memory chip and antennae comprising a ***coiled enameled wire***. Applicant further discloses: a memory chip and an antenna in the form of adhering tags, an

adhering material being located on a surface of the adhering tag, wherein the adhering tag is a soft circuit board.

As admitted by the Examiner on p. 5 of the outstanding Office Action, Son fails to teach an antenna which is a coiled enameled wire.

Bashan et al. fails to provide this deficiency in Son. Applicants respectfully submit that the reference cited by the Examiner as teaching an antenna only teaches a substrate 11 onto which the coil antenna 40 may be etched in a known manner, or by other means, such as deposition or wires. See, e.g., column 4, lines 53-65. However, Bashan et al. fail to teach or suggest an antenna comprising a coiled enameled wire. Rather, Bashan et al. teach that an antenna is etched on a Printed Circuit Board. Similarly, Bashan et al. fail to cure the deficiencies with respect to the obviousness rejections based on Seita in view of Bashan et al.

On p. 3 of the outstanding Office Action, the Examiner cites Col. 6, ll. 55-65 and Col. 7, ll. 19-25 of Himmel as teaching a “adhering tag is a soft circuit board (flexible film) and is coated with an adhering material on a surface of said adhering tag.” However, Applicant has reviewed the cited portions and concluded that neither of the cited portions teaches anything about ***an adhering material*** on a surface of an adhering tag.

Arisawa is cited as teaching a plurality of components which are a diode and a capacitor. However, Arisawa fails to teach: an adhering material on a surface of an adhering tag.

Even if the teachings of Son, Seita, Bashan et al, Himmel, and Arisawa were combined, as suggested by the Examiner, the resultant combination does not suggest: a radio frequency identification including a memory chip and antenna comprising a coiled enameled wire.

Nor does the combination suggest: a memory chip and an antenna in the form of adhering tags, an adhering material being located on a surface of the adhering tag, wherein the adhering tag is a soft circuit board.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicants' disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed. Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday

morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed. Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in the cited references that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Additionally, the cited references do not teach or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicants' claimed structure. Applicants hereby respectfully submit that no combination of the cited prior art renders obvious Applicants' claims.

Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicants' local attorney be contacted at the exchange listed below.

Respectfully submitted,

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